

**REMARKS**

Claims 1-29 are currently pending in the subject application and are presently under consideration.

Applicant's representative thanks Examiner Bayard for the courtesies extended during the telephonic interview conducted on April 9, 2007. Examiner was contacted to discuss the rejection of independent claim 21 under 35 U.S.C. §101, and the interpretation of the cited art references Thomas (EP 1 241 890) and Mandato (EP 1 130 869) with respect to the features of the independent claims. With regard to the rejection of independent claim 21 under 35 U.S.C. §101, applicant's representative asserted that instant messaging software that provides a means for plural concurrent instant message user logins produces a useful, tangible, and concrete result, and is therefore allowable under 35 U.S.C. §101. Examiner indicated that she would have to consult this point with her colleagues before she could withdraw the rejection. Additionally, Examiner's interpretation of cited art references Thomas and Mandato with respect to plural concurrent instant message user logins was discussed. Applicant's representative could not find language in either of these cited references to suggest plural concurrent instant message user logins. Examiner indicated that she would like to review these references again in light of our telephonic discussion.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

**I. Rejection of Claim 21 Under 35 U.S.C. §101**

Claim 21 stands rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. The Federal Circuit has clearly established in *Eolas Techs. Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1338 (Fed. Cir. 2005) and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. (Fed. Cir. 1999) that inventions such as that claimed by applicant is statutory.

This court must also decide whether software code made in the United States and exported abroad is a "component of a patented invention" under 271(f)... Section 271(f) refers to "components of a patented invention."... Title 35, section 101, explains that an

invention includes "any new and useful process, machine, manufacture or composition of matter."... Without question, *software code alone qualifies as an invention eligible for patenting under these categories*, at least as processes. *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1338 (Fed. Cir. 2005). (Emphasis added).

The Federal Circuit in *Eolas Techs., Inc. v. Microsoft Corp.* clearly established that software code alone is statutory subject matter. Independent claim 21 recites *multi-user computer instant messaging software in computer readable media*. By the standards set forth in the above decision, a computer-implemented system in the form of software, hardware, or the combination of both clearly falls within the categories of statutory subject matter.

Moreover, independent claim 21 teaches software that provides plural concurrent instant message user logins on a multi-user computer. The Examiner asserts that the claim is directed to nonfunctional descriptive material. Applicant's representative notes that instant messaging software and a means for logging a user into same is a functional invention that provides a useful, tangible, and concrete result, and is therefore statutory subject matter allowable under 35 U.S.C. §101.

In view of at least the foregoing, it is readily apparent that applicant's invention as recited in independent claim 21 is statutory subject matter. Accordingly, withdrawal of this rejection is respectfully requested.

## **II. Rejection of Claims 21-25 and 27-29 Under 35 U.S.C. §102(a)**

Claims 21-25 and 27-29 stand rejected under 35 U.S.C. §102(a) as being anticipated by Thomas (EP 1 241 890). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Thomas does not teach or suggest each and every limitation of applicant's claimed invention.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes *each and every* limitation set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631,

2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The subject claims teach an instant messaging system that provides instant message communication between computers, including *multi-user* computers. The claimed system allows multiple users of a shared multi-user computer to be logged into the instant messaging system *simultaneously* on the same shared multi-user computer. In this way, multiple instant messaging sessions may be active simultaneously on the same shared multi-user computer. In particular, independent claim 21 recites *multi-user computer instant messaging software in computer readable media, comprising software for providing plural concurrent instant message user logins on a multi-user computer.*

Thomas does not teach or suggest the aforementioned aspects of the subject claims. Thomas teaches a television chat system that allows television viewers to engage in real-time communication in chat groups with other television viewers while watching television. Contrary to the Examiner's assertions in Section 4a of the Office Action dated February 8, 2007, Thomas fails to disclose a method that provides for *plural concurrent* instant messaging user logins on a single multi-user computer. The referenced paragraphs of the cited art, paragraphs [142] and [143], merely disclose a method for creating user profiles on an instant messaging system running simultaneously with video programming, and for selecting a user profile when logging into said instant messaging system. Thomas is silent regarding a method whereby multiple users can be logged into an instant messaging system *simultaneously* on a single shared multi-user computer.

Applicant's subject claims also teach rendering a video display on the multi-user computer concurrently with the instant message user logins. Instant messages are rendered on the multi-user computer over a portion of the video display without a visible window surrounding the instant message. In particular, dependent claim 25 recites *software for rendering an instant message on a multi-user computer over a portion of the video display without a visible window surrounding the instant message.* Contrary to the Examiner's assertions on pages 3 and 4 of the Office Action, Thomas does not teach or suggest displaying an instant message without a visible window surrounding the message. The referenced portion of

the cited art, paragraph [156] and the accompanying Figure 9, only teaches an instant message chat *window* (region 206 of Figure 9) that may be displayed as an opaque or translucent overlay over a video image. The cited art repeatedly refers to instant messages that are bound within a window, but is silent regarding the display of the instant message without a visible window surrounding the instant message.

In addition to the features discussed above, the subject claims teach that each user logged into the claimed instant messaging system on the multi-user computer may *customize the screen position* of his or her incoming instant messages over the video display, so that the recipient of an instant message can be inferred by screen position. In particular, dependent claim 28 recites a *system...in which the instant message is rendered over a user-selectable portion of the video display*. Thomas discloses that any suitable arrangement of chat window and video programming may be used to display instant messages and television programming simultaneously. However, Thomas does not teach or suggest a system that facilitates a *user-selectable* portion of the video display in which to render the instant message. In particular, Thomas teaches a chat window displayed within a portion of video programming, but nowhere teaches or suggests a *user-selectable* portion of the video display.

In view of at least the foregoing, it is respectfully submitted that Thomas does not teach or suggest applicant's invention as recited in independent claim 21 (and claims 22-25 and 27-29 which depend thereon) and thus fails to anticipate the subject claims. Accordingly, withdrawal of this rejection is respectfully requested.

### **III. Rejection of Claims 1-4, 6-13 and 15-20 Under 35 U.S.C. §103(a)**

Claims 1-4, 6-13 and 15-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Thomas (EP 1 241 890) in view of Mandato (EP 1 130 869). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Thomas and Mandato, alone or in combination, fail to teach or suggest each and every limitation of applicant's claimed invention.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** *See MPEP §706.02(j).* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In addition to the system features discussed above, the subject claims teach a system whereby if one of the plural concurrent instant message user logins is a registered buddy of a user of a second computer, then the claimed system sends an indication to the second computer that the registered buddy is one of multiple concurrent instant message user logins on a multi-user computer. The user of the second computer is thus notified of the lack of privacy at the multi-user computer and can tailor the language and content of messages accordingly. In particular, independent claim 1 (and similarly independent claim 11) recites *a multi-user computer instant messaging method...providing plural concurrent instant message user logins on a multi-user computer, one of the plural concurrent instant message user logins being a registered buddy of a user of a second computer; and providing to the second computer an indication that the registered buddy is one of plural concurrent instant message user logins on a multi-user computer.*

The Examiner asserts in Section 6a of the Office Action that Thomas teaches a messaging system that facilitates plural concurrent instant message user logins on a multi-user computer, as recited in the subject claims. However, as discussed *supra* with respect to independent claim 21, which recites a similar feature, Thomas fails to teach or suggest an instant messaging system providing *plural concurrent instant message user logins on a multi-user computer.*

Furthermore, as conceded in Section 6a of the Office Action, Thomas fails to teach or suggest a method for *providing to the second computer an indication that the registered buddy is one of plural concurrent instant message user logins on a multi-user computer.* The Examiner cites Mandato to make up this deficiency of Thomas. However, Mandato only discloses a database for storing and managing instant message user profiles that allows multiple user profiles

to be created for one user, each profile representing a different physical location and /or logical context for that user. The cited art teaches a system that allows a user to define in a database multiple location- and context-specific instant message user profiles (called “contexts” in the cited art), from which the user can choose to activate one, and *only one*, that corresponds to his or her current physical and contextual environment. Paragraph [0039] of the cited art explicitly discloses that *only one user profile of a user is active at the same time*. Mandato does not address the subject of multiple *concurrent* instant message user logins on a shared multi-user computer, and therefore by extension fails to teach or suggest a method for indicating the active status of said concurrent logins to a user of a second computer. The Office Action cites several sections of the cited art that disclose how a user can switch from one “Active Context” (user profile) to another in accordance with the user’s present location and the communication devices available at the time, but in all these references the user has only *one* Context active at a given time, and *the status of other logins on the same computer is not disclosed to users of other computers*. Indeed, such other logins are themselves not discussed in Mandato. Thus, Mandato is silent regarding a method by which the user’s status as being one of plural concurrent instant message user logins on a multi-user computer is indicated to a registered buddy using a second computer, and therefore does not make up for the aforementioned deficiencies of Thomas.

In view of at least the foregoing discussion, it is respectfully submitted that Thomas and Mandato, alone or in combination, do not teach or suggest applicant’s claimed subject matter as recited in independent claims 1 and 11 (and claims 2-4, 6-10, 12, 13, and 15-20 which depend there from), and thus fails to make obvious the subject claimed invention. Accordingly, this rejection should be withdrawn.

#### **IV. Rejection of Claims 5 and 14 Under 35 U.S.C. §103(a)**

Claims 5 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Thomas (EP 1 241 890) in view of Mandato (EP 1 130 869) as applied to claims 1 and 11 above, and further in view of DeCarmo (US 2004/0010808). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Thomas and Mandato, alone or in combination, fail to teach or suggest each and every limitation of applicant’s claimed invention. DeCarmo is also silent regarding the features of applicant’s invention as recited in dependent claims 5 and 14, and therefore fails to make up for this deficiency in Thomas and

**Mandato.**

The subject claims teach that applicant's instant messaging system may render instant messages over a portion of the concurrent video display with a *user-discriminable fade-in and fade-out*, to minimize the distraction of users watching the video content. In particular, dependent claim 5 (and similarly dependent claim 14) recites a *method...in which the instant message is rendered with a user-discriminable fade in and a user-discriminable fade out*. As conceded in the Office Action, Thomas fails to teach or suggest this aspect of applicant's claims. The Examiner cites DeCarmo to make up for this deficiency of Thomas. However, with regard to the rendering of instant messages over a portion of a video display, DeCarmo only teaches a system that assigns a priority level to incoming messages based on the user's preferences. The system then notifies the user of the incoming message in a manner appropriate to the assigned priority level. Specifically, DeCarmo teaches a system that selects the manner in which a user is notified of an incoming instant message according to an assigned priority level, but nowhere teaches or suggests rendering said message over a portion of a video display with a *user-discriminable fade-in and a user-discriminable fade-out*. The referenced paragraphs and figures in the cited art suggest an example system in which a flashing light on a TV set-top box serves as the "Low" priority notification, a short message rendered briefly on the video display serves as the "Medium" priority notification, and an opaque banner containing the instant message rendered on the video display serves as the "High" priority notification. In particular, the cited art teaches that the manner in which messages are rendered on the video display should be in accordance with the priority of the message, but nowhere teaches or suggests rendering said messages on a video display using a *user-discriminable fade-in and a user-discriminable fade-out*.

Moreover, claims 5 and 14 depend from independent claims 1 and 11 respectively. As noted *supra* concerning these independent claims, Thomas does not teach or suggest a system that facilitates *plural concurrent instant message user logins on a shared multi-user computer*. As was also discussed *supra*, Thomas does not teach or suggest a method by which the user's status as being one of plural concurrent instant message user logins on a multi-user computer is indicated to a registered buddy using a second computer. Mandato is also silent regarding this feature of the subject claims and therefore does not make up for the aforementioned deficiencies of Thomas with respect to independent claims 1 and 11. DeCarmo is similarly silent regarding *plural concurrent instant message user logins on a single shared multi-user computer*. As

discussed above, DeCarmo is only concerned with teaching a system that automatically assigns a priority level to an incoming instant message based on the user's preferences, and displays the message to the user in a manner appropriate to the assigned priority level. The cited art only discusses this system with respect to a *single* active user login at any given time, and nowhere discusses *plural concurrent* instant message user logins on a single multi-user computer. Thus, Thomas, Mandato, and DeCarmo, alone or in combination, do not teach or suggest applicant's claimed subject matter as recited in independent claims 1 and 11 (and claims 5 and 14 which respectively depend there from), and therefore fail to make obvious the subject claimed invention.

In view of at least the foregoing, it is respectfully submitted that DeCarmo, alone or in combination with Thomas and Mandato, does not teach or suggest applicant's invention as recited in dependent claims 5 and 14, and thus fails to make obvious the subject claimed invention. As such, withdrawal of this rejection is respectfully requested.

#### **V. Rejection of Claim 26 Under 35 U.S.C. §103(a)**

Claim 26 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Thomas (EP 1 241 890) in view of DeCarmo (US 2004/0010808). Dependent claim 26 recites *a system...in which the instant message is rendered with a user-discriminable fade-in and a user-discriminable fade out*. As discussed *supra* with respect to dependent claims 5 and 14, which recite a similar feature, Thomas and DeCarmo, alone or in combination, fail to teach or suggest rendering an instant message over a portion of a video display *with a user-discriminable fade-in and a user-discriminable fade-out*. The Examiner concedes in the Office Action that Thomas fails to teach or suggest this feature of applicant's invention, and cites DeCarmo to make up for this deficiency in Thomas. However, as discussed above, DeCarmo only teaches that the manner in which an instant message is rendered on a video display should be in accordance with the determined priority level of the message, but nowhere teaches or suggests rendering said message on a video display *using a user-discriminable fade-in and a user-discriminable fade-out*.

Moreover, claim 26 depends from independent claim 21. As noted *supra* with respect to this independent claim, applicant's invention as recited in this independent claim *is statutory subject matter*. Also, as discussed *supra*, Thomas does not teach or suggest a system that facilitates *plural concurrent instant message user logins on a multi-user computer*, a feature

recited in applicant's independent claim 21. DeCarmo is similarly silent regarding *plural concurrent* instant message user logins on a single shared multi-user computer. As discussed above, DeCarmo is only concerned with teaching a system that automatically assigns a priority level to an incoming instant message based on the user's preferences, and displays the message to the user in a manner appropriate to the assigned priority level. The cited art only discusses this system with respect to a *single* active user login at any given time, and nowhere discusses *plural concurrent* instant message user logins on a single multi-user computer. Thus, Thomas and DeCarmo, alone or in combination, fail to teach or suggest each and every aspect of applicant's claimed invention with respect to independent claim 21, from which claim 26 depends.

In view of at least the foregoing, it is respectfully submitted that Thomas, alone or in combination with DeCarmo, does not teach or suggest applicant's invention as recited in dependent claim 26, and thus fails to make obvious the subject claimed invention. As such, withdrawal of this rejection is respectfully requested.

**CONCLUSION**

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP666US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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